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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,698	03/18/2004	Michael E. Miller	65937-0047	6051

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EXAMINER

ROY, ANURADHA

ART UNIT

PAPER NUMBER

3736

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/803,698	Applicant(s) MILLER ET AL.	
	Examiner Anuradha Roy	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 9-14, 17, 21, 25, & 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Voila et al. (US Patent No. 6,554,779).

Please see previous office action of February 28, 2006 for details of rejected claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 15, 18-20, & 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Viola et al in view of Tsonton et al. (US Publication No. 2004/0077972).

In regards to claims 7, 15, 18-20, & 22-24, Viola et al. discloses all of the elements listen in the previous office action of February 28, 2006. However, Viola et al. does not disclose a biopsy device with a pivotable clamp. However, Tsonton et al. discloses a device with a pivotable clamp ([0097] & Figure 25). It would have been obvious to one having ordinary skill

in the art at the time the invention in view of Tsonton et al. to incorporate a pivotable clamp with Viola et al. in order to prevent movement of an object [0118].

Additional Claim Rejections - 35 USC § 103

Claims 8 & 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Viola et al in view of Worm et al. (US Patent No. 6,551,253).

Regarding claims 8 & 16, Viola et al. discloses all of the aforementioned elements. However, Viola et al. does not disclose a deployment system to move a cradle relative to a base. Worm et al., however, teaches of a deployment system (26). It would have been obvious to one having ordinary skill in the art at the time the invention in view of Worm et al. to incorporate a deployment system with Viola et al. in order to advance the biopsy device.

Response to Arguments

Applicant's arguments filed May 23, 2006 have been fully considered but they are not persuasive.

Applicant asserts that Viola et al. neither discloses a “handpiece” nor a “moveable cradle configured to rotatably support a biopsy device.” However, Voila does teach of a handpiece (the device in its entirety), Examiner contends since it is fully capable of being held by a human hand it is a “handpiece.” In regards to the cradle (68), Voila et al. teaches of a “moveably mounted cradle to the base” (See Figure 3). Examiner contends that since the cradle is capable of being removed from the base, the cradle is “movably mounted.” Furthermore, Viola discloses a “cradle configured to rotatably support a biopsy device” (22), since the distal end of the biopsy device (140 & Column 8, lines 60-64) is fully capable of being rotated in a portion of the cradle

(68). Thus, Voila et al. anticipates both a “handpiece” and “moveable cradle configured to rotatably support a biopsy device,” as claimed.

Applicant further argues Viola teaches away from “an indexing guide moveable with the cradle.” However, Examiner contends Viola et al. does teach of “an indexing guide moveable with the cradle” (distal region of 68 & 74) since the “indexing guide” is located on the distal end of the “cradle” and will travel with the cradle. Applicant further states that Viola et al. does not teach of “an indexing guide configured to inhibit rotation and axial movement of the outer cannula hub.” However, Examiner notes that gravitational and frictional forces will inherently inhibit the rotation and axial movement of the outer cannula hub, until an external force is applied. Therefore, Viola et al. anticipates “an indexing guide configured to inhibit rotation and axial movement of the outer cannula hub,” as well as “an indexing guide movable with the cradle.”

In regard to claims 2 & 3, Applicant asserts that Viola et al. does not teach of a “guide lock” or a “guide lock that is selectively engageable.” However, Examiner contends Viola et al. teaches of “guide locks” (76) “selectively engageable with the outer cannula hub” since they can be engaged with the outer cannula hub in order to move the biopsy device or the “guide locks” (76) can remain undisturbed in order to inhibit movement of the biopsy device. Thus, Viola et al. anticipates “guide locks” that are “selectively engageable,” as claimed.

With regard to claim 5, Applicant request Examiner to point out the “notch to prevent movement of the outer cannula.” Voila et al. discloses an “outer cannula hub” (38 to 28) with “a notch to prevent movement” (the gap between 140 and 41). Examiner contends if the “notch” is resting in the “indexing guide” (distal end of 68), then the “notch” prevents the biopsy device

from moving.

In regards to claim 17, Applicant asserts Viola et al. does not disclose that “cradle provides for rotational positioning.” However, the cradle (68) is fully capable of “rotational positioning” of the proximal end of the biopsy device.

Applicant's arguments with respect to claims 7, 8, 15, 16, 18-20, 22-24, 27-29 have been considered but are moot in view of the new ground(s) of rejection.

As a final note, the Applicant is reminded that the use the terms “configured to,” “moveably,” and “rotatably” are directed to the intended use of the cradle or indexing guide, as examples, and have not been positively recited. The applicant should amend the claim to positively recite those limitations lacking from the prior art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anuradha Roy whose telephone number is 571-272-6169 and whose email address is anuradha.roy@uspto.gov. The examiner can normally be reached between 9:00am and 4:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Max Hindenburg can be reached on 571-272-4726.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 3736

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

~AR


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